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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re John Calvani

Serial No. 76479526

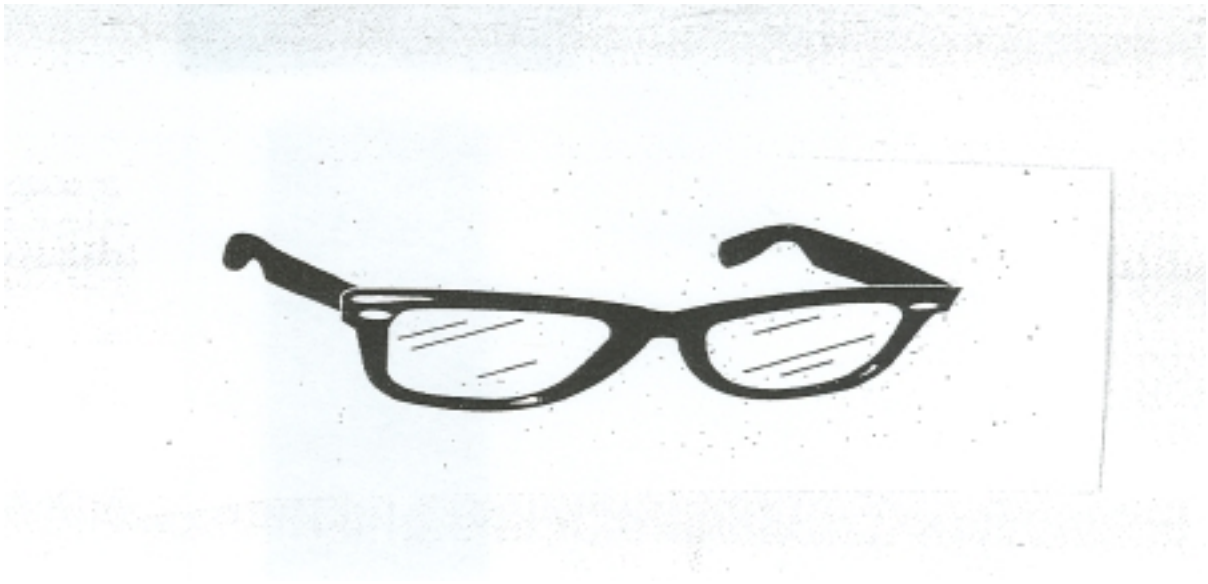
Afschineh Latifi, Esq. for John Calvani.

Monique C. Miller, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

Before Hanak, Hairston and Chapman, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

John Calvani (applicant) seeks to register the design shown below for "men's and women's clothing; namely, shirts, sweaters, jackets, coats, T-shirts, baseball caps, sweat shirts, sweat pants, pants, shorts, socks and footwear." The intent-to-use application was filed on December 19, 2002. In his application, applicant referred to the design shown below as "the design of sunglasses."



Citing Section 2(d) of the Trademark Act, the Examining Attorney refused registration on the basis that applicant's mark, as applied to applicant's goods, is likely to cause confusion with the design mark shown below, previously registered for "clothing, namely hats, shirts, caps, sweat shirts and sports uniforms." Registration No. 2,715,345 issued May 13, 2003.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."). Considering first the goods, we note that they are, in part, identical. The cited registration includes shirts and sweat shirts. Likewise, the recitation of goods in the application includes shirts and sweat shirts.

Turning to a consideration of the marks, we note at the outset that when the goods of the parties are in part legally identical as is the case here, "the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

At page 1 of his brief, applicant reiterates that his design consists of "the design of sunglasses." Moreover, applicant acknowledges at page 1 of his brief that the design of the cited registration is also a "sunglass design." Applicant then goes on to argue at page 2 of his brief that there are differences between his sunglass design and the registered sunglass design. Applicant notes that his lenses are "more square" whereas registrant's lenses are "more rounded." Applicant further notes at page 2 of his brief that "the handles of the glasses are completely different as well, with one being more rounded [presumably applicant's] and the other more sharp edged [presumably registrant's]." However, applicant also acknowledges at page 2 of his brief that one could discern the differences in these two sunglass designs only by means of "a side by side comparison."

The problem with applicant's reasoning is that consumers do not have the luxury of comparing marks on a side-by-side basis. The question this Board must decide is whether a consumer seeing one of registrant's shirts with registrant's sunglass design would, at a later time upon seeing one of applicant's shirts with applicant's sunglass design, assume that the shirts emanated from a common source.

Applying the proper test, we find that a consumer of shirts would not be able to remember the details of either registrant's or applicant's sunglass design trademarks, and would be of the belief that any shirt bearing a sunglass design mark emanated from the same source as other shirts which also had affixed to them a sunglass design.

In short, we find that if applicant were to use his sunglass design on the identical ordinary consumer goods for which registrant previously registered its sunglass design, that there would be a likelihood of confusion.

Decision: The refusal to register is affirmed.